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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/643,276 | 08/22/2000 | Kiyonobu Kojima | SONY-U0059 | 8667 |
| 22850 | 7590 | 01/30/2004 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | DUONG, OANH L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2155 | 8 |

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/643,276

Applicant(s)

KOJIMA ET AL.

Examiner

Oanh L. Duong

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear how transmission information is created **at the same time** as said predetermined file is selected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al (Watanabe) (US 2003/0115277 A1) in view of Shirai et al (Shirai) (US 2001/0042093 A1) in further view of Bernardi et al (Bernardi) (US 5,692,225)

Regarding claim 1, Watanabe teaches a picture transmission apparatus (e.g., see fig. 4) comprising a file select means for selecting a file (e.g., see page 1 paragraph 12-18). Watanabe does not teach transmission information creation means and file save in a state as claimed. However, Shirai teaches transmission information creation means for creating transmission information for transmitting information of a file selected by said file select means, wherein said transmission information is created at the same

time as the file is selected in a batch operation (e.g., see page 6 paragraph 116).

Bernarde teaches file saved in a state of associating picture information with word information upon detection of execution of predetermined operation (e.g., see abstract an col. 10 lines 6-11). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Watanabe with the teachings Shirai and Bernardi because such means would enable the mail tool to extract the information corresponding to a predetermined file and automatically generates an email with an extracted information without any user interaction, thereby efficiently using electronic mail (Shirai, page 2 paragraph 24).

Regarding claim 2, Watanabe teaches transmission information is an electronic mail (e.g., see abstract).

Regarding claim 3, Watanabe teaches transmission information is created so that word information constitutes a text and picture information constitutes an attached file (e.g., see page 4 paragraph 70).

Regarding claim 4, Watanabe teaches a picture transmission method (e.g., see fig. 4) comprising a file select step of selecting a file (e.g., see page 1 paragraph 12-18). Watanabe does not teach transmission information creation means and file save in a state as claimed. However, Shirai teaches transmission information creation means for creating transmission information for transmitting information of a file selected by said file select means, wherein said transmission information is created at the same time as the file is selected in a batch operation (e.g., see page 6 paragraph 116). Bernarde teaches file saved in a state of associating picture information with word information

Art Unit: 2155

upon detection of execution of predetermined operation (e.g., see abstract an col. 10 lines 6-11). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Watanabe with the teachings Shirai and Bernardi because such means would enable the mail tool to extract the information corresponding to a predetermined file and automatically generates an email with an extracted information without any user interaction, thereby efficiently using electronic mail (Shirai, page 2 paragraph 24).

Regarding claim 5, Watanabe teaches transmission information is an electronic mail (e.g., see abstract).

Regarding claim 6, Watanabe teaches word information constitutes a text and picture information constitutes an attached file (e.g., see page 4 paragraph 70).

Regarding claim 7, a program storage medium for storing a program to be executed by an information transmission apparatus of claim 7 has a correspondent apparatus of claim 1; therefore, claim 7 is rejected under the same rationale as applied to claim 1.

Regarding claim 8, Watanabe teaches transmission information is an electronic mail (e.g., see abstract).

Regarding claim 9, Watanabe teaches word information constitutes a text and picture information constitutes an attached file of the email (e.g., see page 4 paragraph 70).

Regarding claim 10, Watanabe teaches a picture transmission apparatus (e.g., see fig. 4) comprising means for activating a still-picture viewing program in which a still

Art Unit: 2155

picture is viewed in a window on a display (e.g., see page 4 paragraph 64); a file select means for selecting a file (e.g., see page 1 paragraph 12-18). Watanabe does not teach transmission information creation means and file save in a state as claimed. However, Shirai teaches transmission information creation means for creating transmission information for transmitting information of a file selected by said file select means, wherein said transmission information is created at the same time as the file is selected in a batch operation (e.g., see page 6 paragraph 116). Bernarde teaches file saved in a state of associating picture information with word information upon detection of execution of predetermined operation (e.g., see abstract an col. 10 lines 6-11). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Watanabe with the teachings Shirai and Bernardi because such means would enable the mail tool to extract the information corresponding to a predetermined file and automatically generates an email with an extracted information without any user interaction, thereby efficiently using electronic mail (Shirai, page 2 paragraph 24).

Regarding claim 11, Watanabe teaches transmission information is an electronic mail (e.g., see abstract).

Regarding claim 12, Watanabe teaches transmission information is created so that word information constitutes a text and picture information constitutes an attached file (e.g., see page 4 paragraph 70).

Regarding claim 13, Watanabe teaches a picture transmission method (e.g., see fig. 4) comprising an activating step of activating a still-picture viewing program in which

Art Unit: 2155

a still picture is viewed in a window on a display (e.g., see page 4 paragraph 64); a file select step of selecting a file (e.g., see page 1 paragraph 12-18). Watanabe does not teach transmission information creation means and file save in a state as claimed.

However, Shirai teaches transmission information creation means for creating transmission information for transmitting information of a file selected by said file select means, wherein said transmission information is created at the same time as the file is selected in a batch operation (e.g., see page 6 paragraph 116). Bernarde teaches file saved in a state of associating picture information with word information upon detection of execution of predetermined operation (e.g., see abstract an col. 10 lines 6-11).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Watanabe with the teachings Shirai and Bernardi because such means would enable the mail tool to extract the information corresponding to a predetermined file and automatically generates an email with an extracted information without any user interaction, thereby efficiently using electronic mail (Shirai, page 2 paragraph 24).

Regarding claim 14, Watanabe teaches transmission information is an electronic mail (e.g., see abstract).

Regarding claim 15, Watanabe teaches word information constitutes a text and picture information constitutes an attached file (e.g., see page 4 paragraph 70).

Regarding claim 16, a program storage medium for storing a program to be executed by an information transmission apparatus of claim 16 has a correspondent

Art Unit: 2155

apparatus of claim 10; therefore, claim 16 is rejected under the same rationale as applied to claim 10.

Regarding claim 17, Watanabe teaches transmission information is an electronic mail (e.g., see abstract).

Regarding claim 18, Watanabe teaches word information constitutes a text and picture information constitutes an attached file of the email (e.g., see page 4 paragraph 70).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh L. Duong whose telephone number is (703) 305-0295. The examiner can normally be reached on Monday- Friday, 8:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

O.D
January 17, 2004

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear how transmission information is created **at the same time** as said predetermined file is selected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al (Watanabe) (US 2003/0115277 A1) in view of Shirai et al (Shirai) (US 2001/0042093 A1) in further view of Bernardi et al (Bernardi) (US 5,692,225)

Regarding claim 1, Watanabe teaches a picture transmission apparatus (e.g., see fig. 4) comprising a file select means for selecting a file (e.g., see page 1 paragraph 12-18). Watanabe does not teach transmission information creation means and file save in a state as claimed. However, Shirai teaches transmission information creation means for creating transmission information for transmitting information of a file selected by said file select means, wherein said transmission information is created at the same

Art Unit: 2155

time as the file is selected in a batch operation (e.g., see page 6 paragraph 116).

Bernarde teaches file saved in a state of associating picture information with word information upon detection of execution of predetermined operation (e.g., see abstract an col. 10 lines 6-11). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Watanabe with the teachings Shirai and Bernardi because such means would enable the mail tool to extract the information corresponding to a predetermined file and automatically generates an email with an extracted information without any user interaction, thereby efficiently using electronic mail (Shirai, page 2 paragraph 24).

Regarding claim 2, Watanabe teaches transmission information is an electronic mail (e.g., see abstract).

Regarding claim 3, Watanabe teaches transmission information is created so that word information constitutes a text and picture information constitutes an attached file (e.g., see page 4 paragraph 70).

Regarding claim 4, Watanabe teaches a picture transmission method (e.g., see fig. 4) comprising a file select step of selecting a file (e.g., see page 1 paragraph 12-18). Watanabe does not teach transmission information creation means and file save in a state as claimed. However, Shirai teaches transmission information creation means for creating transmission information for transmitting information of a file selected by said file select means, wherein said transmission information is created at the same time as the file is selected in a batch operation (e.g., see page 6 paragraph 116). Bernarde teaches file saved in a state of associating picture information with word information

Art Unit: 2155

upon detection of execution of predetermined operation (e.g., see abstract an col. 10 lines 6-11). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Watanabe with the teachings Shirai and Bernardi because such means would enable the mail tool to extract the information corresponding to a predetermined file and automatically generates an email with an extracted information without any user interaction, thereby efficiently using electronic mail (Shirai, page 2 paragraph 24).

Regarding claim 5, Watanabe teaches transmission information is an electronic mail (e.g., see abstract).

Regarding claim 6, Watanabe teaches word information constitutes a text and picture information constitutes an attached file (e.g., see page 4 paragraph 70).

Regarding claim 7, a program storage medium for storing a program to be executed by an information transmission apparatus of claim 7 has a correspondent apparatus of claim 1; therefore, claim 7 is rejected under the same rationale as applied to claim 1.

Regarding claim 8, Watanabe teaches transmission information is an electronic mail (e.g., see abstract).

Regarding claim 9, Watanabe teaches word information constitutes a text and picture information constitutes an attached file of the email (e.g., see page 4 paragraph 70).

Regarding claim 10, Watanabe teaches a picture transmission apparatus (e.g., see fig. 4) comprising means for activating a still-picture viewing program in which a still

Art Unit: 2155

picture is viewed in a window on a display (e.g., see page 4 paragraph 64); a file select means for selecting a file (e.g., see page 1 paragraph 12-18). Watanabe does not teach transmission information creation means and file save in a state as claimed. However, Shirai teaches transmission information creation means for creating transmission information for transmitting information of a file selected by said file select means, wherein said transmission information is created at the same time as the file is selected in a batch operation (e.g., see page 6 paragraph 116). Bernarde teaches file saved in a state of associating picture information with word information upon detection of execution of predetermined operation (e.g., see abstract an col. 10 lines 6-11).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Watanabe with the teachings Shirai and Bernardi because such means would enable the mail tool to extract the information corresponding to a predetermined file and automatically generates an email with an extracted information without any user interaction, thereby efficiently using electronic mail (Shirai, page 2 paragraph 24).

Regarding claim 11, Watanabe teaches transmission information is an electronic mail (e.g., see abstract).

Regarding claim 12, Watanabe teaches transmission information is created so that word information constitutes a text and picture information constitutes an attached file (e.g., see page 4 paragraph 70).

Regarding claim 13, Watanabe teaches a picture transmission method (e.g., see fig. 4) comprising an activating step of activating a still-picture viewing program in which

Art Unit: 2155

a still picture is viewed in a window on a display (e.g., see page 4 paragraph 64); a file select step of selecting a file (e.g., see page 1 paragraph 12-18). Watanabe does not teach transmission information creation means and file save in a state as claimed.

However, Shirai teaches transmission information creation means for creating transmission information for transmitting information of a file selected by said file select means, wherein said transmission information is created at the same time as the file is selected in a batch operation (e.g., see page 6 paragraph 116). Bernarde teaches file saved in a state of associating picture information with word information upon detection of execution of predetermined operation (e.g., see abstract an col. 10 lines 6-11).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Watanabe with the teachings Shirai and Bernardi because such means would enable the mail tool to extract the information corresponding to a predetermined file and automatically generates an email with an extracted information without any user interaction, thereby efficiently using electronic mail (Shirai, page 2 paragraph 24).

Regarding claim 14, Watanabe teaches transmission information is an electronic mail (e.g., see abstract).

Regarding claim 15, Watanabe teaches word information constitutes a text and picture information constitutes an attached file (e.g., see page 4 paragraph 70).

Regarding claim 16, a program storage medium for storing a program to be executed by an information transmission apparatus of claim 16 has a correspondent

Art Unit: 2155

apparatus of claim 10; therefore, claim 16 is rejected under the same rationale as applied to claim 10.

Regarding claim 17, Watanabe teaches transmission information is an electronic mail (e.g., see abstract).

Regarding claim 18, Watanabe teaches word information constitutes a text and picture information constitutes an attached file of the email (e.g., see page 4 paragraph 70).

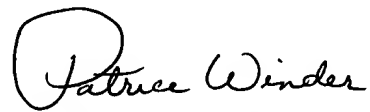
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh L. Duong whose telephone number is (703) 305-0295. The examiner can normally be reached on Monday- Friday, 8:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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O.D
January 17, 2004


PATRICE WINDER
PRIMARY EXAMINER